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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,362	01/24/2000	Steven M. Golden	2166	7063

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EXAMINER	
ALVAREZ, RAQUEL	
ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/490,362	GOLDEN ET AL.	
	Examiner	Art Unit	
	Raquel Alvarez	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/14/2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *61-63* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *61-63* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This office action is in response to communication filed on 10/14/2003.

2. Claims 1-60 have been canceled. Claims 61-63 are presented for examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 61-63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,761,648 in view of Barnett (6,336,099 hereinafter Barnett) and Bezos (5,715,399 hereinafter Bezos). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application further recites automatically redeeming coupons contained in said stored data base when the remote users make transaction using a credit card. Barnett teaches allowing the users to redeem the stored coupons when making purchases electronically/automatically (see figure 1 and col. 11, lines 30-40). Barnett is silent as to the form of payment used to make the purchases. Bezos teaches a method and system for communicating a credit

card number over a network. The customer/user makes an on-line purchase using one or more credit cards (col. 5, lines 24-38) . It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using a credit card to make the purchases because **a credit card facilitates making purchases via telephone or over the network** (in Bezos col. 1, lines 41-42).

4. Claims 61-63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 10/438,582 in view of Barnett and Bezos. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application further recites automatically redeeming coupons contained in said stored data base when the remote users make transaction using a credit card. Barnett teaches allowing the users to redeem the stored coupons when making purchases electronically/automatically (see figure 1 and col. 11, lines 30-40). Barnett is silent as to the form of payment used to make the purchases. Bezos teaches a method and system for communicating a credit card number over a network. The customer/user makes an on-line purchase using one or more credit cards (col. 5, lines 24-38) . It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using a credit card to make the purchases because **a credit card facilitates making purchases via telephone or over the network** (in Bezos col. 1, lines 41-42).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett (6,336,099 hereinafter Barnett) in view of Bezos (5,715,399 hereinafter Bezos).

With respect to claim 61, Barnett teaches establishing electrical communication over the Internet between a service system plurality of remote users having personal computers (i.e. the online service provider 2 transmits product information to a response unit at a customer site)(Figures 1 and 9); receiving at the service system from a plurality of issuer systems instructions for issuing the redeemable coupons (Figure 1, items 14 and 16); receiving profile data at the service system input by the remote users over the Internet (i.e. the online service provider receives user data)(see figures 1 and 9); the service system permitting remote user access to offers for redeemable coupons upon the entry of profile data requested of the remote users by the service system (see figure 1); said offers being accessible over the Internet to selective users based on analysis of the profile data (see figures 1 and 9); storing coupon files in a data base, said coupon files containing information relating to redeemable coupons offered to and selected by the remote users (see Figure 1, item 11).

With respect to automatically redeeming coupons contained in said stored data base when the remote users make transaction using a credit card. Barnett teaches

allowing the users to redeem the stored coupons when making purchases electronically/automatically (see figure 1 and col. 11, lines 30-44). Barnett is silent as to the form of payment used to make the purchases. Bezos teaches a method and system for communicating a credit card number over a network. The customer/user makes an on-line purchase using one or more credit cards (col. 5, lines 24-38) . It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using a credit card to make the purchases because **a credit card facilitates making purchases via telephone or over the network** (in Bezos col. 1, lines 41-42).

With respect to claims 62-63, Barnett further teaches that the coupon file is transmitted to said database via the service system using the Internet (i.e. the Online service provider sends the coupon request file to database 11 using the Internet (See Figures 1 and 10 and col. 13, lines 58-60).

Response to Arguments

7. With respect to the double patenting concerning U.S. Paten No. 5,761,648, the double patenting is sustained. Applicant has agreed to provide a terminal disclaimer therefore no further comment is necessary.

8. With respect to the obviousness-type double patenting rejection concerning application no, 09/484,290. It is noted that US patent application number 10/438,582 had been filed in favor of the 09/484,290 application. The instant claims as amended are not patentably distinct from the 10/438,582 application. New analysis of the claims as amended has been treated in the obviousness-type double patenting rejection

above. Following the procedure stated in MPEP 804, If the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent. This is not the case in the present application because the claims were not only rejected under double patenting rejection but prior art was also applied to reject the claims. Therefore the obviousness-type double patenting rejection has been sustained.

9. With respect to Applicant's argument with respect to the newly added feature, of automatically redeeming coupons contained in said stored database when the remote users make transaction using a credit card. Barnett teaches allowing the users to redeem the stored coupons when making purchases electronically/automatically (see figure 1 and col. 11, lines 30-40). Barnett is silent as to the form of payment used to make the purchases. Bezos teaches a method and system for communicating a credit card number over a network. The customer/user makes on-line purchases using one or more credit cards (col. 5, lines 24-38) . Bezos even recognizes that **a credit card facilitates making purchases via telephone or over the network** (in Bezos col. 1, lines 41-42).

10. In light of the above, it is the Examiner's position that Barnett in combination with Bezos teach the claimed limitations.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Point of contact

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

Raquel Alvarez
Examiner
Art Unit 3622

R.A.
12/16/03